

United States Patent and Trademark Office

UNITED STATES DEPARTMENT OF COMMERCE
United States Patent and Trademark Office
Address: COMMISSIONER FOR PATENTS
P.O. Box 1450
Alexandria, Virginia 22313-1450
www.uspto.gov

APPLICATION N	О.	FILING DATE	FIRST NAMED INVENTOR	ATTORNEY DOCKET NO.	CONFIRMATION NO.	
09/741,823		12/22/2000	Deric Blair Knowles	1330.1099	8801	
21171	7590	12/02/2004		EXAM	INER	
STAAS & HALSEY LLP SUITE 700			;	PATEL, J.	PATEL, JAGDISH	
	-	K AVENUE, N.W.		ART UNIT	PAPER NUMBER	
WASHINGTON, DC 20005				3624	3624 DATE MAILED: 12/02/2004	
				DATE MAILED: 12/02/2004		

Please find below and/or attached an Office communication concerning this application or proceeding.

	Application No.	Applicant(s)					
	09/741,823	KNOWLES ET AL.					
Office Action Summary	Examiner	Art Unit					
	JAGDISH PATEL	3624					
The MAILING DATE of this communication appeared for Reply	ears on the cover sheet with the c	orrespondence address					
A SHORTENED STATUTORY PERIOD FOR REPLY IS SET TO EXPIRE 3 MONTH(S) FROM THE MAILING DATE OF THIS COMMUNICATION. - Extensions of time may be available under the provisions of 37 CFR 1.136(a). In no event, however, may a reply be timely filed after SIX (6) MONTHS from the mailing date of this communication. - If the period for reply specified above is less than thirty (30) days, a reply within the statutory minimum of thirty (30) days will be considered timely. - If NO period for reply is specified above, the maximum statutory period will apply and will expire SIX (6) MONTHS from the mailing date of this communication. - Failure to reply within the set or extended period for reply will, by statute, cause the application to become ABANDONED (35 U.S.C. § 133). Any reply received by the Office later than three months after the mailing date of this communication, even if timely filed, may reduce any earned patent term adjustment. See 37 CFR 1.704(b).							
Status							
1) Responsive to communication(s) filed on 12/22	<u>/2004</u> .						
2a) This action is FINAL . 2b) This	This action is FINAL . 2b)⊠ This action is non-final.						
•	··						
closed in accordance with the practice under E.	closed in accordance with the practice under Ex parte Quayle, 1935 C.D. 11, 453 O.G. 213.						
Disposition of Claims							
4)⊠ Claim(s) <u>1-16</u> is/are pending in the application.	Claim(s) <u>1-16</u> is/are pending in the application.						
4a) Of the above claim(s) is/are withdraw	4a) Of the above claim(s) is/are withdrawn from consideration.						
5) Claim(s) is/are allowed.	Claim(s) is/are allowed.						
6)⊠ Claim(s) <u>1-16</u> is/are rejected.	Claim(s) <u>1-16</u> is/are rejected.						
7) Claim(s) is/are objected to.	Claim(s) is/are objected to.						
8) Claim(s) are subject to restriction and/or	Claim(s) are subject to restriction and/or election requirement.						
Application Papers							
9) The specification is objected to by the Examiner	•						
10) The drawing(s) filed on is/are: a) accepted or b) objected to by the Examiner.							
Applicant may not request that any objection to the drawing(s) be held in abeyance. See 37 CFR 1.85(a).							
Replacement drawing sheet(s) including the correction is required if the drawing(s) is objected to. See 37 CFR 1.121(d).							
11) The oath or declaration is objected to by the Examiner. Note the attached Office Action or form PTO-152.							
Priority under 35 U.S.C. § 119							
12) Acknowledgment is made of a claim for foreign priority under 35 U.S.C. § 119(a)-(d) or (f).							
a) ☐ All b) ☐ Some * c) ☐ None of:							
1. Certified copies of the priority documents have been received.							
2. Certified copies of the priority documents have been received in Application No							
3. Copies of the certified copies of the priority documents have been received in this National Stage							
application from the International Bureau (PCT Rule 17.2(a)).							
* See the attached detailed Office action for a list of the certified copies not received.							
Attachment(s)							
1) Notice of References Cited (PTO-892)	4) Interview Summary	(PTO-413)					
2) Notice of Draftsperson's Patent Drawing Review (PTO-948)	Paper No(s)/Mail Da	ate					
3) Information Disclosure Statement(s) (PTO-1449 or PTO/SB/08) Paper No(s)/Mail Date 4/5/2001.	5) Notice of Informal P 6) Other:	atent Application (PTO-152)					

DETAILED ACTION

Claim Rejections - 35 USC § 101

1. 35 U.S.C. 101 reads as follows:

Whoever invents or discovers any new and useful process, machine, manufacture, or composition of matter, or any new and useful improvement thereof, may obtain a patent therefor, subject to the conditions and requirements of this title.

- 2. Claims 1-16 are rejected under 35 U.S.C. 101 because the claimed invention is directed to non-statutory subject matter.
- 3. Claims not recited within technological art.

As an initial matter, the United States Constitution under Art. I, §8, cl. 8 gave

Congress the power to "[p]romote the progress of science and useful arts, by securing for limited times to authors and inventors the exclusive right to their respective writings and discoveries". In carrying out this power, Congress authorized under 35 U.S.C. §101 a grant of a patent to "[w]hoever invents or discovers any new and useful process, machine, manufacture, or composition or matter, or any new and useful improvement thereof."

Therefore, a fundamental premise is that a patent is a statutorily created vehicle for Congress to confer an exclusive right to the inventors for "inventions" that promote the progress of "science and the useful arts". The phrase "technological arts" has been created and used by the courts to offer another view of the term "useful arts". See In re Musgrave, 167 USPQ (BNA) 280 (CCPA 1970). Hence, the first test of whether an invention is eligible for a patent is to determine if the invention is within the "technological arts".

Further, despite the express language of §101, several judicially created exceptions have been established to exclude certain subject matter as being patentable

subject matter covered by §101. These exceptions include "laws of nature", "natural phenomena", and "abstract ideas". See Diamond v. Diehr, 450, U.S. 175, 185, 209 USPQ (BNA) 1, 7 (1981). However, courts have found that even if an invention incorporates abstract ideas, such as mathematical algorithms, the invention may nevertheless be statutory subject matter if the invention as a whole produces a "useful, concrete and tangible result." See State Street Bank & Trust Co. v. Signature Financial Group, Inc. 149 F.3d 1368, 1973, 47 USPQ2d (BNA) 1596 (Fed. Cir. 1998).

This "two prong" test was evident when the Court of Customs and Patent Appeals (CCPA) decided an appeal from the Board of Patent Appeals and Interferences (BPAI). See In re Toma, 197 USPQ (BNA) 852 (CCPA 1978). In Toma, the court held that the recited mathematical algorithm did not render the claim as a whole non-statutory using the Freeman-Walter-Abele test as applied to Gottschalk v. Benson, 409 U.S. 63, 175 USPQ (BNA) 673 (1972). Additionally, the court decided separately on the issue of the "technological arts". The court developed a "technological arts" analysis:

The "technological" or "useful" arts inquiry must focus on whether the claimed subject matter...is statutory, not on whether the product of the claimed subject matter...is statutory, not on whether the prior art which the claimed subject matter purports to replace...is statutory, and not on whether the claimed subject matter is presently perceived to be an improvement over the prior art, e.g., whether it "enhances" the operation of a machine. In re Toma at 857.

In Toma, the claimed invention was a computer program for translating a source human language (e.g., Russian) into a target human language (e.g., English). The court found that the claimed computer implemented process was within the "technological art" because the claimed invention was an operation being performed by a computer within a computer.

The decision in State Street Bank & Trust Co. v. Signature Financial Group, Inc. never addressed this prong of the test. In State Street Bank & Trust Co., the court found that the "mathematical exception" using the Freeman-Walter-Abele test has little, if any, application to determining the presence of statutory subject matter but rather, statutory subject matter should be based on whether the operation produces a "useful, concrete and tangible result". See State Street Bank & Trust Co. at 1374. Furthermore, the court found that there was no "business method exception" since the court decisions that purported to create such exceptions were based on novelty or lack of enablement issues and not on statutory grounds. Therefore, the court held that "[w]hether the patent's claims are too broad to be patentable is not to be judged under °101, but rather under §§102, 103 and 112." See State Street Bank & Trust Co. at 1377. Both of these analysis goes towards whether the claimed invention is non-statutory because of the presence of an abstract idea. Indeed, State Street abolished the Freeman-Walter-Abele test used in Toma. However, State Street never addressed the second part of the analysis, i.e., the "technological arts" test established in Toma because the invention in State Street (i.e., a computerized system for determining the year-end income, expense, and capital gain or loss for the portfolio) was already determined to be within the technological arts under the Toma test. This dichotomy has been recently acknowledged by the Board of Patent Appeals and Interferences (BPAI) in affirming a §101 rejection finding the claimed invention to be non-statutory. See Ex parte Bowman, 61 USPQ2d (BNA) 1669 (BdPatApp&Int 2001).

In the present application, Claims 1-16 have no connection to the technological arts. None of the steps indicate any connection to a computer or technology. Example: claim 1 recites process steps "requesting...", "completing..." and "recording" can be broadly interpreted as being manually performed. Although the preamble recites the method as being computer implemented, no limitation supports this intended objective,

i. e. none of the method steps recite computer implementation. Therefore, claim 1 is rendered outside the technological art and therefore is rendered non statutory under 35 U.S.C. §101 guidelines. Independent claim 11 is similarly analyzed.

Claim Rejections - 35 USC § 112

4. The following is a quotation of the second paragraph of 35 U.S.C. 112:

The specification shall conclude with one or more claims particularly pointing out and distinctly claiming the subject matter which the applicant regards as his invention.

Claims 9, 10 and 14-16 are rejected under 35 U.S.C. 112, second paragraph, as being indefinite for failing to particularly point out and distinctly claim the subject matter which applicant regards as the invention.

The aforementioned claims are indefinite because of the following deficiencies:

Claim 9 recites limitation "defining or redefining stages of a procurement process" which does not functionally relate to any process step of parent claim 1.

Claim 10 recites limitation "automatically changing states according to variable rules" which does not functionally relate to any process step of parent claim 1.

Claim 14 recites limitation "may be mandatory or optional" renders the claim indefinite because the scope of the claim cannot be ascertained definitively.

Claim 15: see claim 9 analysis.

Claim 16: see claim 10 analysis.

Application/Control Number: 09/741,823

Page 6

Art Unit: 3624

Claim Rejections - 35 USC § 102

5. The following is a quotation of the appropriate paragraphs of 35 U.S.C. 102 that form the basis for the rejections under this section made in this Office action:

A person shall be entitled to a patent unless --

- (b) the invention was patented or described in a printed publication in this or a foreign country or in public use or on sale in this country, more than one year prior to the date of application for patent in the United States.
- 6. Claims 1-8, 11-13 are rejected under 35 U. S. C. 102(b) as being clearly anticipated by Shoquist et al. (US 5,361,199) (hereafter Shoquist).

<u>Claim 1:</u> Shoquist teaches a computer implemented method for facilitating the procurement of goods and services, comprising:

requesting any one of a plurality of procurement entities; (refer to Buyer Work Station BWS 20 Fig. 1, refer to col.4 L 1-8)

completing procurement items associated with the requested procurement entity; and

recording the procurement items.

(refer to col. 5 L 12-22 and L 37-45, RFPs require processing, recording is interpreted as part of processing)

<u>Claim 2.</u> The computer implemented method for facilitating the procurement of goods and services according to claim 1, wherein said procurement entity is a virtual procurement folder.

Application/Control Number: 09/741,823

Art Unit: 3624

Page 7

(BWS 20 request documents for RP and POS electronically as

explained in col. 5)

<u>Claim 3.</u> The computer implemented method for facilitating the procurement of goods

and services according to claim 2, wherein said virtual procurement folder comprises a

plurality of the procurement items.

(refer to Figure 3 which shows various procurement items)

Claim 4. The computer implemented method for facilitating the procurement of goods

and services according to claim 3, wherein the procurement items are associated with

different stages of procurement

process.

(col. 6 L 16-35 and Fig. 8A)

Claim 5. The computer implemented method for facilitating procurement of goods and

services according to claim 3, the procurement items comprise a plurality of procurement

records. (see claim 1 analysis).

Claim 6. the procurement items comprise a plurality of mandatory and optional events

(see Fig. 3 work list menu).

Claims 7 and 8. procurement entity has an associated procurement identifier and

the procurement entity may be requested by the procurement identifier (Figure 4).

Application/Control Number: 09/741,823
Art Unit: 3624

<u>Claim 11.</u> Shoquist teaches a computer-implemented method for facilitating the procurement of goods and services comprising:

requesting procurement items associated with any stage of a procurement process; (refer to Buyer Work Station BWS 20 Fig. 1, refer to col. 5 L 37-50)

completing procurement items associated with the requested procurement entity; and

recording the procurement items.

(refer to col. 5 L 12-22 and L 37-45, RFPs require processing, recording is interpreted as part of processing)

claims 12 and 13: wherein the procurement items comprise procurement records.

..procurement events (claim 12) and ..a plurality of procurement events (claim 13). (refer to analysis of claims 5 and 6).

Conclusion

7. The prior art made of record and not relied upon is considered pertinent to applicant's disclosure.

Any inquiry concerning this communication or earlier communications from the examiner should be directed to JAGDISH PATEL whose telephone number is (703)308-7837. The examiner can normally be reached on 800AM-600PM M-Th.

If attempts to reach the examiner by telephone are unsuccessful, the examiner's supervisor, Vincent Millin can be reached on (703)308-1065. The fax phone number for the organization where this application or proceeding is assigned is 703-872-9306.

Application/Control Number: 09/741,823

Art Unit: 3624

Information regarding the status of an application may be obtained from the Patent Application Information Retrieval (PAIR) system. Status information for published applications may be obtained from either Private PAIR or Public PAIR. Status information for unpublished applications is available through Private PAIR only. For more information about the PAIR system, see http://pair-direct.uspto.gov. Should you have questions on access to the Private PAIR system, contact the Electronic Business

Center (EBC) at 866-217-9197 (toll-free).

agdish N. Patel

(Primary Examiner, AU 3624)

11/29/04